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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,024	10/01/2004	Marcus Eh	3968.123	4639
41288	7590	07/25/2005		
PENDORF & CUTLIFF 5111 MEMORIAL HIGHWAY TAMPA, FL 33634-7356			EXAMINER ZUCKER, PAUL A	
			ART UNIT 1621	PAPER NUMBER

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/510,024

**Applicant(s)**

EH, MARCUS

**Examiner**

Paul A. Zucker

**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,7,8,10 and 12 is/are rejected.
- 7) ☒ Claim(s) 2-4,6,9 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

5-0-0

## **DETAILED ACTION**

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7 and 8 are drawn to compositions that comprise the compounds of formula (1) but no other component. It is therefore unclear whether compounds or compositions are being claimed. Claims 7 and 8 are therefore rendered indefinite. EXAMINER'S SUGGESTION: Applicants should amend the claims, consistent with the specification, to include at least one additional component such as, for example, a carrier.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5, 7, 8, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Shleppnik (US 4,622,221 11-1986). Shleppnik discloses (Column 9, line 64-column 11, line 38) the compounds 2-cyclohexyl-2-propyl acetate, 2-cyclohexyl-2-propyl propionate, 2-cyclohexyl-2-propyl isobutyrate, 2-cyclohexyl-2-propyl butyrate. The compounds correspond to those instantly claimed with following allowed variable identities:  $R^3, R^4, R^5, R^6=H$ ;  $R^1, R^2=CH_3$ ; Y = methyl, ethyl, isopropyl and propyl, respectively. Shleppnik discloses (Column 9, line 64-column 10, line 20) synthesis of the acetate via the reaction of 2-cyclohexyl-2-propanol with acetic anhydride. Shleppnik discloses (Column 13, lines 50-68, Table 1n entries 9-12) the use of these compounds in fragrance compositions contained in aerosol can products. Shleppnik therefore anticipates claims 1, 5, 7, 8, 10 and 12.

### ***Claim Objections***

4. Claims 2-4, 6, 9 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Allowable Subject Matter***

1. Claims 2-4, 6, 9 and 11 are drawn to allowable subject matter. The following is a statement of reasons for the indication of allowable subject matter: The instantly claimed compounds, compositions and processes are neither disclosed nor fairly suggested by the closest prior art: Shleppnik (US 4,622,221 11-1986), Giersch et al

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(US 5,166,412 11-1992) and Williams (US RE38,659 11-2004). The instantly claimed compounds differ from those taught by Giersch et al in that the instantly claimed compounds that contain the 3,3-dimethylcyclohexyl group required by Giersch lack the hydrogen atom required by Giersch on the methylene carbon connecting the cyclohexane ring and the oxygen atom. The instantly claimed compounds in which R<sup>5</sup> and R<sup>6</sup> taken together are oxygen differ from those taught by Williams in the same fashion. Neither Giersch nor Williams disclose or fairly suggest the modifications of the structure they disclose required to produce the instantly claimed compounds. The instantly claimed compounds are therefore patentable over the teachings of Shleppnik, Giersch and Williams, the closest prior art.

### ***Conclusion***

5. Claims 1-12 are pending. Claims 1, 5, 7, 8, 10 and 12 are rejected. Claims 2-4, 6, 9 and 11 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**PAULA A. ZUCKER, PH.D.**  
**PRIMARY EXAMINER**